

**REMARKS**

Claims 1-47 and 49-66 were pending at the time the present Office Action was mailed (February 15, 2007). In this response, claims 1, 11, 18, 22, 26, 31, 34, 49, 52, 57, and 61 have been amended and claim 67 has been added.

The Examiner rejected the claims under 35 U.S.C. § 103(a) as set forth in the following table. Applicant respectfully traverses these rejections below.

Claims	References
1-7, 11, 14, 16-18, 20-23, 26-27, 29-32, 34-40, 43-45, 49, 51-54, 57-59, and 61-66	Ryan (6,173,274) and Giacomozi (WO 96/29263)
8-9, 24, 28, 42, and 56	Ryan, Giacomozi, and Iltkonen (5,473,863)
10, 25, 33, 41, 55, 60, and 64	Ryan, Giacomozi, and Crossman (5,035,515)
12-13, 15, 19, 46-47, and 50	Ryan, Giacomozi, and Loeb (6,421,652)

Claim 1 is directed to a computer system for processing a paper product. The computer system includes a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer. The paper product includes a roll of paper or a plurality of unbound, stacked paper sheets. The computer system further includes a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product. The computer system also includes a paper product tracker configured to provide instructions for creating the enclosure for the paper product. The enclosure has the promotional material of the received promotional material order. The paper product tracker is also configured to provide instructions to enclose the paper product of the received order with the created enclosure. The paper manufacturer, the paper purchaser, and the third-party advertiser are different entities, and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product.

Claim 1 has been amended to clarify that the promotional material received by the promotions order tracker "is specifically targeted to a group of people associated with the

paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." This amendment is supported by applicant's specification which describes in part, "[a]nother advantage of an embodiment of the promotion system and method described above with reference to FIGS. 1-7 is that the advertisements on the paper packaging materials can be specifically targeted to those paper purchasers most likely to purchase the advertised goods or services." Specification, paragraph [0046].

Ryan discloses a production mail system for printing messages, such as advertisements, on envelopes addressed to a single, specific recipient. For example, Ryan discloses that determining the message, "involves taking into consideration the hygienized recipient address 50 and reconciling the preference data 804b and restriction data 804c of the user," where the user is the sender of the message. Ryan, col. 11:63-66. During operation, the sender submits a mailing list to the data processing system for processing. The mailing list includes multiple recipient addresses to which the sender wishes to send mail pieces. The data processing system reviews the mailing list and determines which recipients should have advertisements printed on their envelopes. The data processing system also selects advertisements for each specific recipient based on the advertiser's restriction data, the recipient's address, and the demographic information in an address demographics database. As a result, a specific advertisement is printed on each envelope that is targeted to the recipient of the envelope.

Giacomozi discloses wrappers for paper handkerchiefs that have advertisements printed on the outside of the wrappers. The advertisements are not linked to the handkerchiefs and Giacomozi does not exercise any control over who will see each advertisement. In particular, the advertisements are not targeted to any specific person or group of people.

In direct contrast, applicant's technology is related to placing advertisements on paper products that are specifically targeted to a group of people that are likely to be

exposed to the paper products. Applicant's technology is distinguished from Ryan for at least the reason that Ryan's system targets advertisements to a single individual (the recipient of the letter). Applicant's technology is distinguished from Giacomozzi for at least the reason that Giacomozzi's system does not exercise any control over who receives or sees the advertisements.

The Examiner relies on Ryan for teaching receiving an order for a paper product (i.e., mail pieces) and placing promotional material on the enclosure of the paper product. The Examiner relies on Giacomozzi for teaching that the manufacturer from which the paper product is obtained is a paper manufacturer. Even taken in combination, Ryan and Giacomozzi fail to disclose all of the elements of applicant's claims. In particular, the combination of Ryan and Giacomozzi fails to disclose or suggest targeting advertisements to a group of people associated with a paper purchaser. As described above, Ryan targets advertisements to a single recipient of a letter, and Giacomozzi does not target advertisements at all.

Even if Ryan and Giacomozzi, taken together, disclosed all the claimed features, there is no suggestion in either of the references or the field in general to make such a combination. In fact, Ryan teaches away from placing promotional material on Giacomozzi's wrappers. Specifically, Ryan teaches away from placing promotional material on items when "the third party advertiser cannot exercise any control over who receives the message." Ryan, col. 2:65-66. Thus, Ryan teaches away from placing promotional material on Giacomozzi's wrappers because the advertiser cannot exercise any control over who receives the message. Rather, the message is received by random individuals who either purchase Giacomozzi's handkerchief packages or notice the promotional message on one of Giacomozzi's handkerchief packages. This is precisely the type of advertising Ryan's invention is designed to avoid. As the Examiner correctly noted previously, Ryan's invention is directed at "resolv[ing] this problem by giving advertisers control over targeting their messages." Office Action, August 16, 2006, p. 10. Accordingly, the Examiner's suggested use of Ryan's system to print promotional material

onto Giacomozzi's wrappers contravenes one purpose of Ryan's invention—overcoming the disadvantage of conventional advertising campaigns in which "the third party advertiser has no assurance that a target audience would be reached." Ryan, col. 2:67 – col. 3:1.

In addition, Giacomozzi teaches away from combining his disclosed features with those of Ryan. Giacomozzi's system is directed to displaying promotional messages to the public at large, not messages targeted to a specific recipient (including the purchaser of the paper handkerchiefs). For example, Giacomozzi states, "[t]he wrapping containing paper handkerchiefs, in fact, is pulled out and shown, by the user, to the public each time a handkerchief is taken from the same, and this represents a possible publicity vehicle with large diffusion." Giacomozzi, p. 1. Ryan targets promotional messages to the single recipient of a message, in direct conflict with the large diffusion for which Giacomozzi is designed. Therefore, one skilled in the art would not be motivated to combine Ryan's disclosed features with those of Giacomozzi, or Giacomozzi's disclosed features with those of Ryan. For at least the foregoing reasons, Ryan and Giacomozzi fail to establish a *prima facie* case for rejecting claim 1 under Section 103. Therefore, claim 1 is patentable over the combination of Ryan and Giacomozzi. Moreover, none of the other relied upon references teach at least this element of claim 1. Accordingly, applicant respectfully requests that this rejection be withdrawn.

The dependent claims of claim 1 are patentable over the combination of Ryan and Giacomozzi for at least the foregoing reasons and for the additional features of these claims. In rejecting claims 8-9, the Examiner relies on Itkonen for teaching a roll of paper. In rejecting claim 10, the Examiner relies on Crossman for teaching promotional messages that are coupons. However, Itkonen and Crossman fail to cure the deficiencies described above with reference to Ryan and Giacomozzi for at least the reason that Itkonen and Crossman fail to disclose or suggest targeting advertisements to a group of people associated with a paper purchaser. Therefore, claims 2-10 and 66-67 are patentable over the references relied on by the Examiner for the reasons discussed above and based on the additional features of these dependent claims.

The remaining pending claims include elements generally similar to those discussed above with reference to claim 1. Independent claims 11, 22, 31, 49 and 65 include promotional material "specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." Independent claim 18 includes an advertisement "specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." Claims 12-17, 19, 20, 23-30, 32-47, 50, 51 and 53-64 all depend from one of the foregoing independent claims. Accordingly, for at least the foregoing reasons and for the additional features of these dependent claims, the Section 103 rejections of these claims should be withdrawn.

Based on the foregoing amendments and remarks, applicant respectfully requests reconsideration of this application and its early allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3265. Applicant believes all required fees are being paid in connection with this response. However, if an additional fee is due, please charge our Deposit Account No. 50-0665, under Order No. 335828001US1 from which the undersigned is authorized to draw.

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